



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,677	05/15/2001	Hideyuki Yano	35.C15360	8069

5514 7590 02/14/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

GRAINGER, QUANA MASHELL

ART UNIT PAPER NUMBER

2852

DATE MAILED: 02/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,677

Applicant(s)

YANO, HIDEYUKI

Examiner

Quana Grainger

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 7-13 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2852

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 7-12-01 has been considered.

Title

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi. The image forming apparatus by Hayashi comprising an image bearing body for bearing a toner image; a conveying member for bearing and conveying a recording material; and a transferring member for transferring a toner image on said image bearing body to the recording material conveyed by said conveying member by being

Art Unit: 2852

applied a voltage, wherein said transferring member has ion conductivity (Figure 1; abstract). The image bearing body and the number of said transferring member are provided plurally, corresponding to plural color toners, and said image bearing body and said transferring member oppose to each other via said conveying member. The plural image bearing bodies and transferring members are arranged in a conveying direction of said conveying material, and plural color toner images are multiply transferred on a recording material one after another by a conveyance of said conveying member. The conveying member has an endless shape.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. in view of Kimura et al. Hayashi et al. does not teach a double-sided mode.

Kimura et al. teaches an image forming apparatus wherein said image forming apparatus has a double-side mode for forming images on both sides of a recording material and further comprises developing means for developing a latent image on said image bearing body by a reversal developing method. The examiner takes official notice that it is known in the art to use a recording medium made of resin and a transfer medium made with sponge and having a surface roughness. It would have been

Art Unit: 2852

obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Kimura et al. with the image forming device of Hayashi et al. to perform printing on both side of a recording medium. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a recording medium made of resin and a transfer medium made with sponge and having a surface roughness as is known in the art.

Allowable Subject Matter

Claims 2-3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 2 recites an image forming apparatus according to claim 1, wherein a change in a resistance value of said transferring member under a voltage of 1000 to 3000 V applied to said transferring member is within one digit. Claim 3 recites an image forming apparatus according to claim 1, wherein a resistance value of said transferring member under a voltage of 1000 V applied to said transferring member is 10^7 to 10^9 ohms. Claim 6 recites an image forming apparatus according to claim 1, wherein said conveying member has ion conductivity.

Prior Art of Record

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hasegawa, Nakamura, and Takeuchi all teach ion conduction transfer members.

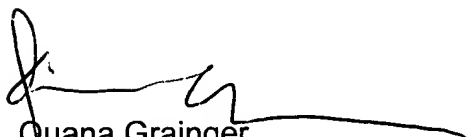
Art Unit: 2852

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quana Grainger whose telephone number is 703 308-7616. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on 703 308-1373. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3230 for regular communications and 703 305-3230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Quana Grainger
Primary Examiner
February 11, 2002